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REMARKS

Claims 1 - 19 are pending in the present Application. Claims 1, 5, 18 and 19 have been amended, leaving Claims 1 - 19 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Amended Claims

Claims 1, 5, 18 and 19 have been amended to better define the invention. Support for these amendments can be found in the original claims as filed. No new matter has been introduced by these amendments.

Rejection under 35 U. S. C. § 102 (b)

Claims 1, 2, 4 – 8, 13 – 17 and 19 are rejected under 35 U. S. C. § 102 (b) as allegedly being anticipated by U.S. Patent No. 6,083,428 to Ueda et al (hereinafter Ueda) (Office Action dated 07/14/2004, page 2).

In making the rejection, the Examiner has stated that "conductive carbon fibers would inherently meet the limitation of anti-static/conductive agent filler in Claims 1 – 4" (Office Action dated 07/14/2004, page 2). Applicant respectfully disagrees.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Claim 1 of the application as presently amended is directed to an antistatic composition comprising a polycarbonate resin; an impact modifier comprising a polycarbonate-polysiloxane copolymer; an antistatic agent; and a flame retardant in an amount greater than or equal to about 9 wt% of the total composition. Claim 19 is directed at a method of manufacturing the composition of Claim 1.

Ueda teaches a flame-retardant resin composition that comprises 100 parts by weight of a thermoplastic resin and 0.1 to 30 parts by weight of one or more of organic phosphorus compounds (Abstract). Ueda teaches that the inorganic fillers such as carbon fibers, charcoal and the like, may be added to the resin composition (Col. 11, lines 1 – 7).

Ueda teaches the use of impact modifiers such as acryl-silicone composite rubbers (Col. 10, line 29 – 55). However, Ueda does not teach the use of an impact modifier comprising a polycarbonate-polysiloxane copolymer as presently claimed. For this reason at least, Ueda does not teach all of the claimed elements and therefore cannot anticipate the present invention. Applicant respectfully requests a withdrawal of the rejection under 35 U. S. C. § 102 (b) and an allowance of the claims.

Rejections under 35 U. S. C. § 103 (a)

Claims 1 – 19 are rejected under 35 U. S. C. § 103 (a) as being allegedly unpatentable over JP 11-199,767 to Kataoka (Kataoka) in view of JP 11-181,267 to Kawahigashi et al. (Kawahigashi) or U. S Patent No. 6,21,939 to Campbell et al. (Campbell) or GB 2043083 to William et al. (William) (Office Action dated 07/14/2004, page 4).

In making the rejection, the Examiner has stated that

> It would have been obvious to one with ordinary skill in the art to improve the polycarbonate based antistatic /flame retardant compositions of Kataoka by optionally substituting the rubbery polymer with polysiloxane per the teachings of Kawahigashi to benefit from improved resistance to the oxidation and elastic properties . . .

(Office Action dated 07/14/2004, pages 4 - 5). Applicant respectfully disagrees.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was make. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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Kataoka: Kataoka teaches a composition comprising (A) 50-80% aromatic polycarbonate resin, (B) 4.5-15% polyetheresteramide, (C) 3-12% phosphoric ester, (D) 1-25 wt.% of at least one inorganic filler selected from among talc having an average particle size of 0.5-10 μm, mica, glass flakes, and wollastonite having an average particle size of 0.5-10 μm, (E) 0.5-8% rubbery polymer, and (F) 0.05-1.5% polytetrafluoroethylene capable of forming fibrils (see Solution). In the examples, Kataoka teaches that the rubbery polymer is a polyacrylate-polysiloxane copolymer. Kataoka does not teach impact modifiers that comprise polycarbonate-polysiloxane copolymers as presently claimed and therefore does not teach all elements of the claimed invention.

Kawahigashi: Kawahigashi teaches a fire retardant polycarbonate resin composition that contains (A) polycarbonate resin and (B) titanium oxide powder in a weight ratio of (A) to (B) of (70:30)-(90:10), and is blended with (C) 1-8 pt.wt. alkylbenzene sulfonic acid based static resistant agent, (D) 100-3,000 ppm wt. phosphorus-based antioxidant and (E) 0.01-5 pt.wt. organopolysiloxane containing alkoxy group based on (100 pts.wt.) total weight of the components (A) and (B), and also a light reflecting plate is produced by forming the above composition (see Solution). The organopolysiloxane taught by Kawahigashi is not a copolymer of polycarbonate and polysiloxane. Thus Kawahigashi does not make up for the deficiency of Kataoka. Additionally, since Kawahigashi does not teach polycarbonate-polysiloxane copolymers, one of ordinary skill in the art would find no motivation to combine Kawahigashi with Kataoka.

Campbell: Campbell teaches resin compositions comprising a thermoplastic resin and at least one phosphoramide having a glass transition point of at least about 0°C (see Abstract). Campbell too, like Kawahigashi and Kataoka does not teach an impact modifier that comprises a copolymer of polycarbonate and polysiloxane. Campbell therefore does not make up for the deficiency of Kataoka or Kawahigashi. Further since Campbell does not teach a copolymer of polycarbonate and polysiloxane, one of ordinary skill in the art would have no motivation to combine it with either Kataoka or Kawahigashi.

William: William teaches flame retardant thermoplastic compositions comprising polyphenylene ether resins, with or without a styrene resin, and a flame retardant agent (see Abstract). Williams does not teach an impact modifier that comprises a polycarbonate-polysiloxane copolymer. Williams therefore does not make up for the deficiency of Campbell, Kataoka or Kawagishi. Further, since Williams does not teach a polycarbonate-polysiloxane copolymer one of ordinary skill in the art would not have combined it with Campbell, Kataoka or Kawahigashi.

Further, even if the Examiner were to maintain that there was motivation to combine the aforementioned references, which there is not, the claimed combination produces unexpected results. A review of the Comparative Examples 2 and 3 in Table 1 on page 16 of the specification shows that when polycarbonate-polysiloxane impact modifiers are used in polycarbonate resins in conjunction with a flame retardant in an amount of less or equal to about 9 wt%, the flame retardancy as expressed by p(FTP) is significantly less than 1. However, when the amount of flame retardant is increased above 9 wt% as seen in the Examples 4, 5 and 7, a flame retardancy of V-1 is achieved while maintaining impact properties of greater than or equal to about 6 ft-lb/inch. The surface resistivity in the Examples 4, 5 and 7 is less than 1×10^{13} ohm/sq. These results demonstrate that the combination of the polycarbonate-polysiloxane copolymer together with flame retardant in an amount of greater than or equal to about 9 wt% in a polycarbonate resin produces an unexpected synergy as well as an unexpected combination of properties. In this conjunction the courts have held that "[a]n applicant can rebut a prima facie case of obviousness by presenting comparative test data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not have." *In re Dillon*, 919 F.2d 688, 692-93, 16 U.S.P.Q.2d 1987, 1901 (Fed. Cir. 1990).

In conclusion, since the combination made by the Examiner does not teach all the elements of the claimed invention, since there is no motivation to combine references, Applicants respectfully request a withdrawal of the rejection under 35 U. S. C. § 103 (a) and an allowance of the claims.

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Claims 1 – 19 are rejected under 35 U. S. C. § 103 (a) as being unpatentable over Ueda in view of Kataoka or Campbell or William (Office Action dated 07/14/2004, page 4).

As explained above, neither Ueda, Kataoka, Campbell or William teaches the use of an impact modifier comprising a polycarbonate-polysiloxane copolymer in a flame retardant, high impact polycarbonate resin. Thus the combination made by the Examiner would not produce the claimed invention. Further, since neither Ueda, Kataoka, Campbell or William teaches the use of a polycarbonate-polysiloxane copolymer, one of ordinary skill in the art would find no motivation to combine them. For these reasons at least, Applicants respectfully request a withdrawal of the rejection under 35 U. S. C. § 103 (a) and an allowance of the claims.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-2341.

Respectfully submitted,

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